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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/718,747
Filing Date: November 21, 2003
Appellant(s): SOUDER ET AL.

Benny Souder, et al.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 10, 2008 appealing from the Office action

mailed June 29, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| 6,272,503 | Bridge, Jr. et al. | 8-2001 |
| 5,758,345 | Wang | 5-1998 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 18-28 and 40-44 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. in 6,272,503 issued to Bridge, Jr. et al., ("Bridge").

As per claim 1, Bridge discloses "a method for automatically provisioning data in a distributed database system" (i.e., automatically importing (transporting) to target database; see col. 14, lines 2-26), the method comprising computer-implemented steps:

"a database server causing a tablespace to be transported from a first file system to a second file system" (i.e., transferring tablespace between two databases; see col. 9, lines 41-50); and

"after transporting said tablespace to said second file system, said database server importing said tablespace into a local database managed by said database server" (i.e., transferring tablespace from source database to target database; see col. 9, lines 44-50 and Fig. 12a).

As per claim 2, Bridge discloses "a database server causing a tablespace to be transported and the step of said database server importing said tablespace are both performed in response to invocation of a routine" (see col. 9, lines 46-50).

As per claim 3, Bridge discloses "said routine is written in code that conforms to a database language and that may be executed by a database server" (i.e., executing by processor instructions; see col. 5, lines 32-39).

As per claim 4, Bridge discloses "importing includes attaching said tablespace to said local database" (see col. 9, lines 44-46).

As per claim 5, Bridge discloses "the tablespace is attached to another database before and during performance of the step of said database server causing a tablespace to be transported" (see col. 10, lines 16-21).

As per claim 6, Bridge discloses "the tablespace is offline before and during performance of the step of said database server causing a tablespace to be transported" (see col. 10, lines 21-21).

As per claim 18, in addition to claim 1, Bridge further discloses "wherein said set of one or more files store data for a database" (i.e., collecting one or more datafile; see col. 9, lines 23-24).

As per claim 19, the limitations of claim 19 are similar to claim 4, therefore, the limitations of claim 19 are rejected in the analysis of claim 4, and this claim is rejected on that basis.

As per claim 20, in addition to claim 1, Bridge further discloses "metadata describing database objects and commands for inserting data into the database objects, wherein the step of provisioning includes importing said database data into said database by executing commands" (see col. 3, lines 25-34).

As per claim 21, in addition to claim 1, Bridge further discloses "said set of one or more files includes backup files created by a recovery manager, wherein the step of provisioning includes causing said recovery manager to create said database managed by said database server from said backup files" (see col. 6, line 64 to col. 7, line 5).

As per claim 22, in addition to claim 1, Bridge further discloses "an archive log stores data recording changes to said database made after creating the backup files, wherein the step of provisioning further includes changing said database to reflect changes recorded in said archive log" (see col. 6, line 64 to col. 7, line 5).

As per claim 23, in addition to claim 1, Bridge further discloses "a computer-readable medium carrying one or more sequences of instructions which, when executed by one or more processors, causes the one or more processors to perform the method" (i.e., instructions which, when executed by one or more processors; see col. 5, lines 5-11).

As per claims 24-28 and 40-44, the limitations of claims 24-28 and 40-44 are computer-readable medium carrying one or more sequences of instructions, which are similar to the method claims 1-9 and 23, therefore, the limitations of claims 24-28 and 40-44 are rejected in the analysis of claims 1-9 and 23, and these claims are rejected on that basis.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 7-9 and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over of U.S.

Patent No. in 6,272,503 issued to Bridge, Jr. et al., ("Bridge") in view of U.S. Patent No. 6,859,768 issued

to 5,758,345 issued to Wang, ("Wang").

As per claim 7, Bridge discloses "importing the tablespace includes attaching a copy of the

tablespace, wherein the copy is different than said tablespace" (i.e., importing and copying to target

database system; see col. 13, lines 48-55 and Fig. 13a and 13b). Bridge fails to explicitly disclose said

database server provisions a synchronization mechanism that applies changes made to the tablespace to

the copy. However, Wang discloses said database server provisions a <u>synchronization</u> mechanism that

applies changes made to the tablespace to the copy (see Wang col. 14, line 59 to col. 15, line10). It

would have been obvious to a person of ordinary skill in the art at the time the invention was made to

modify the method of Bridge by database server provisions a <u>synchronization</u> mechanism that applies

changes made to the tablespace to the copy as disclosed by Wang (see Wang col. 14, lines 59-66). Such

a modification would allow the method of Bridge to provide a method which is portable among different

database vendors, therefore, improving the reliability of automatic and dynamic of provisioning of

databases.

As per claims 8 and 9, the limitations of claims 8 and 9 are similar to claim 7, therefore, the limitations of claims 8 and 9 are rejected in the analysis of claim 7, and these claims are rejected on that basis.

As per claims 29-31, the limitations of claims 29-31 are computer-readable medium carrying one or more sequences of instructions, which are similar to the method claims 1-9 and 23, therefore, the limitations of claims 29-31 are rejected in the analysis of claims 1-9 and 23, and these claims are rejected on that basis.

(10) Response to Argument

The Examiner will address the arguments in the order submitted by the appellants.

Argument:

On page 4, paragraph 3, Appellants argued "The Office Action is correct in that Bridge does teach transferring a tablespace from a source database to a target database. However, a general teaching about performing an operation does not by itself disclose or suggest each and every specific way of performing that operation. Disclosure of a genus does not necessarily disclose or suggest every species of the genus. It does not necessarily follow from the fact that a tablespace is transported between file systems that the transporting of tablespaces is being caused by a database server as claimed, for reasons given above."

Response:

It is noted Bridge discloses transferring data between two databases has two phases, a user a set of tablespaces, containing the desired data, from a source database, the database system gets a specification of the tablespaces to be transferred, received the name of an export or import file from the user; see col. 9, lines 35-46. Further, in column 5, lines 24-29, Bridge discloses transfer data between databases (wherein the database comprises six tablespaces; col. 5, lines 53-57 and Fig. 4). The arguments are not persuasive.

Argument:

On page 5, paragraph 3, Appellants stated "... Bridge tails to teach at least some features of claim 1, and therefore fails to teach all the features of claim 1."

Response:

It is noted Bridge discloses "*a method for automatically provisioning data in a distributed database system*" i.e., automatically importing (transporting) to target database; see col. 14, lines 2-26, "*the method comprising computer-implemented steps a database server causing a tablespace to be transported from a first file system to a second file system*" i.e., transferring tablespace between two databases; see col. 9, lines 41-50; "and after transporting said tablespace to said second file system" i.e., transferring tablespace from source database to target database; see col. 9, lines 44-50 and Fig. 12a, "*said database server importing said tablespace into a local database managed by said database server*" i.e., transfer data between databases (wherein the database comprises six tablespaces; col. 5, lines 53-57 and Fig. 4). Bridge discloses the claimed limitations.

Argument:

On page 5, paragraph 3, Appellants stated "... Bridge tails to teach at least some features of claim 1, and therefore fails to teach all the features of claim 1."

Response:

It is noted Bridge discloses "*a method for automatically provisioning data in a distributed database system*" i.e., automatically importing (transporting) to target database; see col. 14, lines 2-26, "*the method comprising computer-implemented steps a database server causing a tablespace to be transported from a first file system to a second file system*" i.e., transferring tablespace between two databases; see col. 9, lines 41-50; "and after transporting said tablespace to said second file system" i.e., transferring tablespace from source database to target database; see col. 9, lines 44-50 and Fig. 12a,

"*said database server importing said tablespace into a local database managed by said database server*"

i.e., transfer data between databases (wherein the database comprises six tablespaces; col. 5, lines 53-

57 and Fig. 4). Bridge discloses the claimed limitations.

        Argument:

         On page 7, last paragraph, appellants argued that "Bridge fails to teach at least some features of

claim 20, and therefore fails to teach all the features of claim 20."

        Response:

        It is noted Bridge discloses using the DLL statements in the export/import file and inserted into

the target database's data dictionary, and also in Fig. 13c, the tablespaces in the pluggable set are

assigned new tablespace numbers; see col. 13, lines 56-61.

        Argument:

         On page 8, last paragraph, appellants argued that "Bridge fails to teach at least some features of

claim 21, and therefore fails to teach all the features of claim 21."

        Response:

        It is noted Bridge discloses step of recovering logs, allowing the portion of a disk pointer; see col.

64 to col. 7, line 5.

        Argument:

        On page 9, paragraph 3, appellants argued "Bridge fails to teach at least some features of claim

22, and therefore fails to teach all the features of claim 22."

Response:

It is noted Bridge discloses tablespaces function as a unit of object placement, space administration, and point-in-time recovery, every datafile within a database belongs to exactly one tablespace, and whenever a new datafile is added to a database, it is always added to a specific tablespace; see col. 5, lines 45-49.

Argument:

On page 11, paragraphs 3 and 4, appellants argued "Wang does not teach that the synchronization mechanism it teaches about is provisioned by a database server. Based on the foregoing, Bridge fails to teach at least some features of claim 7, and therefore fails to teach all the features of claim 7."

Response:

The examiner recognizes obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the instant application relates to a distributed database systems, and allocating resources in a database system to meet varying workload demands; see specification; paragraph [0003].

Accordingly, Bridge discloses a method and apparatus for indicating location of data items within a database; see col. 4, lines 54-55.

Further, in column 5, lines 24-29, Bridge discloses the computer system to transfer data between databases; and column 3, lines 43-45, a set of tablespaces forming a partition of and containing the set of datafiles.

Wand discloses a distributed system; see col. 2, lines 32-34. Further, in column 4, lines 2-4, Wang discloses steps of providing a facility which allows application programs executing on different nodes to access a logical volume, to each node. Further, in column 8, lines 39-42, Wang discloses a tablespace, which indicates datafiles associated with that tablespace are evenly spread across all nodes.

Therefore, the combination of Bridge and Wand discloses the claimed limitations.

Moreover, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

And the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Thus, Wang discloses said database server provisions a synchronization mechanism that applies changes made to the tablespace to the copy (see Wang col. 14, line 59 to col. 15, line10). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the method of Bridge by database server provisions a synchronization mechanism that applies changes made to the tablespace to the copy as disclosed by Wang (see Wang col. 14, lines 59-66). Such a modification would allow the method of Bridge to provide a method which is portable among different database vendors, therefore, improving the reliability of automatic and dynamic of provisioning of databases.

MPEP 2111: During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification" Applicant always has the opportunity to amend the claims during prosecussion and broad interpretation by the examiner reduces the possibility that the

claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969). The court found that applicant was advocating … the impermissible importation of subject matter from the specification into the claim. See also In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997) (The court held that the PTO is not required, in the course of prosecution, to interpret claims in applications in the same manner as a court would interpret claims in an infringement suit. Rather, the "PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definition or otherwise that may be afforded by the written description contained in application's specification.").

The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Jean Bolte Fleurantin

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